

o/0021/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003769559

BY FRANCISCO ANTONIO NOVAS DESCHAMPS

TO REGISTER THE TRADE MARK:

Shahi Naan Kebab

IN CLASS 43

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600002469

BY SHEKIO ASLAM

BACKGROUND AND PLEADINGS

1. On 24 March 2022, Francisco Antonio Novas Deschamps (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 10 June 2022. The applicant seeks registration for the following services:

Class 43 Takeaway food services; Restaurants; Restaurant services; Provision of food and drink in restaurants.

2. The application was opposed by Shekio Aslam (“the opponent”) on 12 July 2022. The opposition is based upon sections 5(1) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade mark:



The Shahi Nan Kabab

UK registration no. UK00002476734

Filing date 8 January 2008.

Registration date 20 June 2008.

Relying upon all of the services for which the mark is registered, namely:

Class 43 Providing restaurant, buffet and takeaway services.

3. The applicant filed a counterstatement denying the claims made in the opponent’s Notice of Opposition (Form TM7F). The applicant states that the marks are different and therefore unlikely to confuse the public.

4. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20 (4) shall continue to apply. Rule 20 (4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

5. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. Evidence was filed within the opponent’s Notice of Opposition (Form TM7F); however, no leave was sought to file any further evidence in respect of these proceedings.

6. Rule 62 (5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

7. The opponent and applicant are unrepresented. A hearing was neither requested nor considered necessary, nor did the parties file any submissions in lieu. I make this decision having taken full account of all the papers, and the evidence, referring to them as necessary.

8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

DECISION

9. Section 5(1) of the Act reads as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trademark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

10. Section 5(2) reads as follows:

“5(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the trade mark is protected

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

11. The earlier mark has completed its registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at s.6A of the Act apply. However, as the applicant did not request that the opponent prove use of its mark, it is entitled to rely upon all of the services without demonstrating that it has used the mark.

Identity of the marks

12. It is a prerequisite of section 5(1) that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.”

13. The words “Nan” and “Naan”, and “Kabab” and “Kebab” differ in the opponent’s and applicant’s marks. I also note that the applicant’s mark is presented in a stylised font, and encased in a black rectangular outline. These act as visual points of difference between the marks. I do not, therefore, consider these marks to be identical.

14. As section 5(1) requires the marks to be identical, the opponent's claim under this ground falls at the first hurdle.

15. The opposition based upon section 5(1) is dismissed.

Section 5(2)(b) case law

16. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

17. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme

v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

18. I consider that all of the applicant’s services; “takeaway food services”, “restaurants”, “restaurant services” and “provision of food and drink in restaurants” falls within the broader category of “providing restaurant, buffet and takeaway services” in the opponent’s specification. I consider the services identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

19. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

20. The average consumer for the services will be members of the general public. The services are likely to vary in cost and frequency of purchase. However, the average consumer will take various factors into consideration such as the cost, the type of cuisine offered and customer service standards. Consequently, the level of attention paid during the purchasing process will be medium.

21. The services are likely to be purchased following perusal of signage on premises frontage or perusal of adverts and menus online. Therefore, visual considerations are likely to dominate the selection process.

22. However, I do not discount that there will also be an aural component to the purchase of the services given that they may be booked over the telephone, or a recommendation for the services may have been given through word-of-mouth.

Comparison of the trade marks

23. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

24. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

25. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
<div data-bbox="226 338 762 452" style="border: 1px solid black; padding: 5px; text-align: center;"> <p>The Shahi Nan Kabab</p> </div>	<p>Shahi Naan Kebab</p>

26. The opponent's mark consists of the words "The Shahi Nan Kabab", in a stylised black typeface, encased in a black rectangular outline. I consider that the word "Shahi" is the dominant and distinctive part of the mark, due it being an invented word with no conceptual meaning. I consider that the wording "Nan Kabab" will be recognised and understood by the average consumer as the words "Naan Kebab", albeit spelt slightly differently, especially as it is being used on the opponent's providing restaurant, buffet and takeaway services. Therefore, I consider that as the wording "Nan Kabab" will be recognised as a type of dish, which is typically a flatbread with grilled meat, fish or vegetables, it is therefore allusive of the opponent's services, and plays a lesser role within the overall impression of the mark. I also consider that the word "The" plays a lesser role, along with the stylisation and the black rectangular outline within the mark. I consider that the word "Shahi" plays a greater role in the overall impression of the mark.

27. The applicant's mark consists of the words "Shahi Naan Kebab". I consider that the invented word "Shahi" is the dominant and distinctive part of the mark, and therefore plays a greater role in the overall impression of the mark. The words "Naan Kebab" which is allusive of the applicant's services, therefore plays a lesser role in the overall impression.

28. Visually the marks coincide in the word "Shahi". I note that the marks overlap in the letters N, A and N which appear within the middle word of the marks, albeit the applicant's trade mark contains an additional A. I also note that the marks overlap in the letters K, B, A and B within the end word of the marks, however, the second letter of the end word in the opponent's mark is the letter A, and the second letter of the end word in the applicant's mark is the letter E. I also note that the opponent's mark starts

with the word “The”, and is presented in a stylised typeface encased in a black rectangular outline. These act as slight visual points of difference. Consequently, I consider that that the marks are visually similar to between a medium and high degree.

29. Aurally, the opponent’s mark will be pronounced as THE SHA-HI N-AN KAH-BAB. The applicant’s mark will be pronounced as SHA-HI N-AN KEY-BAB. Therefore as the marks overlap in the pronunciation of 5 syllables, I consider that the marks are aurally similar to between a medium and high degree.

30. Conceptually, I consider that the average consumer would recognise the word “Shahi” as an invented word with no conceptual meaning in both the applicant’s and opponent’s marks. I consider that the words “Naan Kebab” in the applicant’s mark will be recognised as a food dish which is composed of a flatbread filled with pieces of skewered meat, fish or vegetables which would have been grilled. I also consider that this meaning will be assigned to the words “Nan Kabab” in the opponent’s mark, as the words are spelt only slightly differently, and are being used on providing restaurant, buffet and takeaway services.

31. Therefore as the words “Nan Kabab” and “Naan Kebab” in the opponent’s and applicant’s mark will be recognised as the same type of dish, which I note is allusive of their services, I consider that the marks are conceptually identical.

Distinctive character of the earlier trade mark

32. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases*

C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR 1-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promotion of the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51).”

33. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

34. I will begin by assessing the inherent distinctive character of the earlier trade mark.

35. As highlighted above, the opponent’s mark consists of the words “The Shahi Nan Kabab”, in a stylised black typeface, encased in a black rectangular outline. The word “Shahi” is the dominant and distinctive part of the mark, due it being an invented word with no conceptual meaning. Although spelt slightly differently, I consider that the average consumer will recognise the words “Nan Kabab” as meaning “Naan Kebab”, (a type of dish composed of a flatbread typically filled with pieces of skewered meat, fish or vegetables), especially as it is being used on providing restaurant, buffet and takeaway services. Therefore, taking the above into account, I consider that the mark is inherently distinctive to between a medium and high degree.

36. I note that the opponent has not pleaded that its mark has acquired enhanced distinctiveness. However, for the sake of completeness, I will make a finding as to

whether I consider the evidence provided by the opponent is sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

37. The opponent has provided sales figures to enable me to assess the extent of use made of its mark. Its turnover is “in excess of £250,000” with a typical unit price amounting to £7. I also note that between 2017 to 2019 the “cost on trademark” amounts to £7,650. However, it is unclear as to what “cost on trademark” means, and therefore I am unsure what these figures pertain to. The only evidence provided to support these figures is an undated picture of the opponent’s shop front, an undated photograph of the opponent’s menu, an undated screenshot from its Instagram page showing that it has 1,879 followers and an undated picture of its “renowned chilli sauce bottle”. I also note that sealed court documents have been provided in relation to the opponent’s proceedings in the court, however, this is not relevant to these proceedings.

38. Albeit I have been provided with sales figures, these are not supported by any invoice evidence, or UK market share figures. The evidence does not show geographical spread of the mark within the UK. I also have not been provided with advertising figures. Therefore, taking all the above into account, I do not consider that the above is sufficient to demonstrate enhanced distinctiveness.

Likelihood of confusion

39. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive

to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

40. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to between a medium and high degree.
- I have found the marks to be aurally similar to between a medium and high degree.
- I have found the marks to be conceptually identical.
- I have found the opponent's mark to be inherently distinctive to between a medium and high degree.
- I have identified the average consumer to be members of the general public who will select the services primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the services.
- I have found the parties' services to be identical.

41. Taking all of the factors listed in paragraph 40 into account, bearing in mind that the opponent's mark is distinctive to between a medium and high degree, and the principle of imperfect recollection, I consider that the marks will be mistakenly recalled or misremembered as each other. This is particularly the case given the relatively high visual similarity (to between a medium and high degree) between the marks and the predominantly visual purchasing process. Even where aural considerations play a greater role, the higher aural similarity (to between a medium and high degree) between the marks will have the same result.

42. As established above, the marks share the dominant and distinctive element "Shahi". Therefore I consider that the average consumer would easily overlook the "The" element in the opponent's mark. I also consider that the average consumer

would easily overlook the slightly different spellings of “Nan”/ “Naan”, and “Kabab”/ “Kebab” in the opponent’s and applicant’s marks, especially as they have the same conceptual meaning (flatbread filled with grilled meat, fish or vegetables), which is allusive of the opponent’s and applicant’s restaurant, buffet and takeaway services. Furthermore, I consider that the average consumer would overlook the stylistic differences between the marks, such as the black rectangular outline and the stylised typeface in the opponent’s mark. I consider that, in the absence of any conceptual hook between the marks (as they are conceptually identical) the average consumer will not have a strong conceptual message to assist them in differentiating between the opponent’s and applicant’s marks. Lastly, the average consumer rarely has the opportunity to compare marks side-by-side and will instead encounter them in different settings at different times. To my mind, the closeness between the marks, and the nature of the services’ purchase will lead the average consumer to fall foul of the effects of imperfect recollection. In other words, consumers of the earlier mark will, upon seeing the later mark, displayed on identical services, will erroneously believe that the mark is that of the opponent (or vice versa). Therefore, taking all of the above into account, I consider there to be a likelihood of direct confusion.

CONCLUSION

43. The opposition is fully successful under section 5(2)(b) and the application is refused.

COSTS

44. Award of costs in fast track proceedings are governed by TPN 2/2015. The opponent has been successful and would normally be entitled to a contribution towards their costs.

45. However, as the opponent is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the opponent and invited them to indicate whether they intended to make a request for an award of costs. The opponent was informed that, if so, they should complete a Pro Forma, providing details of their actual costs and accurate estimates of the amount of time spent on various activities associated with

the proceedings. They were informed that “if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time) may not be awarded”.

46. The opponent did not file a completed Pro Forma. That being the case I award the opponent the sum of £100 in respect of the official fee only.

47. I therefore order Francisco Antonio Novas Deschamps to pay Shekio Aslam the sum of **£100**. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 10th day of January 2023

L FAYTER

For the Registrar